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UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/053,788	01/18/2002	Motoi Sato	13700-269115	4278

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JOHN S. PRATT, ESQ
KILPATRICK STOCKTON, LLP
1100 PEACHTREE STREET
ATLANTA, GA 30309

EXAMINER
DURAN, ARTHUR D

ART UNIT	PAPER NUMBER
3622	

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

		Application No.	Applicant(s)
		10/053,788	SATO ET AL.
Office Action Summary		Examiner	Art Unit	
		Arthur Duran	3622	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>07 May 2007</u>.

2a)☒ This action is **FINAL**.   2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) <u>1-18</u> is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) <u>1-18</u> is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
    Paper No(s)/Mail Date _____.

4) ☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____.

5) ☐ Notice of Informal Patent Application

6) ☐ Other: _____.

DETAILED ACTION

1.   Claims 1-18 have been examined.

Response to Amendment

2.   The Remarks filed on 5/7/07 are insufficient to overcome the prior rejection.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in
> section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are
> such that the subject matter as a whole would have been obvious at the time the invention was made to a person
> having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the
> manner in which the invention was made.

3.   Claims 1-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Greening

(2001/0013009) in view of Bergh (6,112,186).

Claims 1, 9, 17, 18: Greening discloses a recommended item presentation method,

comprising the steps of:

(a) obtaining client identifier associated client preference estimating factor

information of a plurality of clients which is information according to which a

preference of each client is to be estimated; and

(b) receiving a recommended item presentation request and a client preference estimating

factor information of one client from an item provider server for providing items to a plurality

of clients through a network, where the client preference estimating factor

information indicates a preference of the one client,[ ], producing a recommended item list

according to the client identifier associated client preference estimating factor information and

the client preference estimating factor information, and transmitting the

recommended item list to the item provider server (Abstract; Figures 1, 2, 4, 6, 7, 11).

Greening does not explicitly disclose without identifying the one client.

However, Bergh discloses managing user privacy or not identifying the client (col 31,

line 65-col 32, line 20).

Therefore, it would have been obvious to one having ordinary skill in the art at the time

the invention was made to add Bergh not identifying the client to Greenings recommendations

disclosure. One would have been motivated to do this in order to better accommodate user

desired exposure levels.

Additionally, Bergh further discloses "without requiring information to identify that

client". Bergh discloses these features:

"(160) It is desirable to provide users with an ability to control the

entities to which the central server 70 will transmit data about that user. It

is further desirable to allow the users to select certain types of information

which should not be transmitted e.g., a user may wish to have preference data

transmitted but not demographic data" (col 31, lines 48-55).

Hence, Bergh discloses that user preferences can be utilized for recommendations even if

user demographic or identifying information is not known.

Bergh goes on to describe how user privacy can be controlled by having control over

each piece of user relevant information and whether or not that information is to be shared (col

31, line 65-col 32, line 20). Hence, Bergh can have privacy control over any user related

information or user identifying or demographic or preference information.

Therefore, it would be obvious to Greening that both preferences related to identifying

information and preferences related to private/non-identifying information can be utilized for

recommendations. Please see the motivation above.

Claim 2, 10: The combination of the prior art discloses the above. Greening further

discloses that the step (a) obtains the client identifier associated client preference estimating

factor information by receiving a client preference estimating factor information list

from a client preference estimating factor information list providing server

which collects the client identifier associated client preference estimating

factor information from a plurality of clients (Abstract, [15]).

Claims 3, 11: The combination of the prior art discloses the above. Greening further

discloses that the step (a) receives the client identifier associated client preference estimating

factor information list in a form of a list of item identifiers of viewed/purchased

items at the item provider server and dates and times of viewings/purchases of

the viewed/purchased items for each client identifier, or a list of item

identifiers of viewed/purchased items at the item provider server and ratings

indicating levels of interest of each client with respect to the

viewed/purchased items for each client identifier, or a list of item

identifiers of interested items of each client for each client identifier (Abstract, [15]).

Claim 4, 5, 12, 13: The combination of the prior art discloses the above. Greening does

not explicitly disclose the step of paying a fee for transmission of the client identifier associated

client preference estimating factor information list to the client preference

estimating factor information list providing server.

Greening does not explicitly disclose the step of receiving a fee for transmission of the

recommended item list from the item provider server.

However, Bergh discloses charging a fee for providing relevant information (col 32, line

50-col 33, line 27).

Therefore, it would have been obvious to one having ordinary skill in the art at the time

the invention was made to add Bergh's charging a fee for providing relevant information. One

would have been motivated to do this in order to better provide a source of revenue.

Claims 6, 14: The combination of the prior art discloses the above. Greening further

discloses that the step (a) also processes the client identifier associated client preference

estimating factor information into a client preference estimating factor information map

and the step (b) produces the recommended item list according to the client

preference estimating factor information map and the client preference

estimating factor information (Abstract; Figures 11, 3, 1, 2, 4, 6, 7).

Claims 7, 15: The combination of the prior art discloses the above. Greening further

discloses that the step (a) produces the client preference estimating factor information map in a

form of any of a list of item identifiers of accessed items of each client for each

client identifier, a list of item identifiers of accessed items of each client

and ratings indicating levels of interest of each client with respect to the

accessed items for each client identifier, a list of client identifiers of

accessing clients of each item for each item identifier, a list of client

identifiers of accessing clients of each item and ratings indicating levels of

interest of each client with respect to each item for each item identifier, and

a list of correlation values among correlated items (Abstract; Figures 11, 3, 1, 2, 4, 6, 7).

Claims 8, 16: The combination of the prior art discloses the above. Greening further

discloses that the step (b) produces the recommended item list by: obtaining a related client list

by extracting client identifiers contained in a list of client identifiers for

each item that constitutes the client preference estimating factor information

map, for each item identifier in a list of item identifiers that constitutes

the client preference estimating factor information received along with the

recommended item presentation request from the item provider server; narrowing

down the related client list by extracting item identifiers contained in a list

of item identifiers for each client that constitutes the client preference

estimating factor information map, for each client identifier in, the related

client list, counting a number of overlaps between extracted item identifiers

and item identifiers in the list of item identifiers that constitutes the

client preference estimating factor information, for each client identifier in

the related client list, rearranging client identifiers in the related client

list in a descending order of counted number of overlaps, and setting a first

prescribed number of client identifiers from a top of a rearranged related

client list as a new related client list; obtaining a related item list by

extracting item identifiers contained in the list of item identifiers for each

client, for each client identifier in the new related client list; and

narrowing down the related item list by extracting client identifiers contained

in the list of client identifiers for each item, for each item identifier in

the related item list, counting a number of overlaps between extracted client

identifiers and client identifiers in the new related client list, for each

item identifier in the related item list, rearranging item identifiers in the

related item list in a descending order of counted number of overlaps, and

setting a second prescribed number of item identifiers from a top of a

rearranged related item list as the recommended item list (Greening, Figures 1, 4-11; [18, 42,

43, 45, 68, 69]).

Also, Bergh discloses features relevant to the steps in Applicant's claims 8 and 16

(Bergh, Figures 1, 2, 3; col 10, lines 10-46).

Response to Arguments

4.   Applicant's arguments with respect to the claims have been considered but are not found

persuasive.

On page 3 and 4 of the Applicant's Remarks dated 5/7/2007, Applicant states that:

"Greening does not describe or suggest "receiving a recommended item presentation

request and a client preference estimating factor information of one client from an item provider

server", since Greening describes obtaining a request from a client. Nor does Greening describe

"providing items to a plurality of clients through a network, where the client preference

estimating factor information indicates a preference of the one client, without identifying the one

client", since Greening describes information that identifies a specific client. . .

Therefore, Bergh does not disclose or suggest "receiving a recommended item

presentation request and a client preference estimating factor information of one client from an

item provider server for providing items to a plurality of clients through a network, where the

client preference estimating factor information indicates a preference of the one client, without

identifying the one client", as recited in step (b) of Claim 1. Moreover, Bergh does not disclose

or suggest producing the recommended item list from (1) and (2) (as described above), without

requiring information to identify that client, as recited in step (b) of Claim 1."

Examiner notes that while specific references were made to the prior art, it is actually

also the prior art in its entirety and the combination of the prior art in its entirety that is being

referred to. Also, one cannot show nonobviousness by attacking references individually where

the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208

USPQ 871 (CCPA 1981); *In re Merck & Co.,* 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

And, Examiner notes that it must be presumed that the artisan knows something about the

art apart from what the references disclose. In re Jacobv, 309 F.2d 513, 135 USPQ 317 (CCPA

1962). The problem cannot be approached on the basis that artisans would only know what they

read in references; such artisans must be presumed to know something about the art apart from

what the references disclose. In re Jacoby. Also, the conclusion of obviousness may be made

from common knowledge and common sense of a person of ordinary skill in the art without any

specific hint of suggestion a particular reference. In re Bozek, 416 F.2d 1385, USPQ 545 (CCPA

1969). And, every reference relies to some extent on knowledge or persons skilled in the art to

complement that which is disclosed therein. In re Bode, 550 F.2d 656, USPQ 12 (CCPA 1977).

And, Bergh does disclose "without requiring information to identify that client". Bergh discloses these features:

"(160) It is desirable to provide users with an ability to control the entities to which the central server 70 will transmit data about that user. It is further desirable to allow the users to select certain types of information which should not be transmitted e.g., <u>a user may wish to have preference data transmitted but not demographic data</u>" (col 31, lines 48-55).

Hence, Bergh discloses that user preferences can be utilized for recommendations even if user demographic or identifying information is not known.

Bergh goes on to describe how user privacy can be controlled by having control over each piece of user relevant information and whether or not that information is to be shared (col 31, line 65-col 32, line 20). Hence, Bergh can have privacy control over any user related information or user identifying or demographic or preference information.

Therefore, it would be obvious to Greening that both preferences related to identifying information and preferences related to private/non-identifying information can be utilized for recommendations.

Also, Examiner notes that it is the Applicant's claims as stated in the Applicant's claims that are being rejected with the prior art. Also, although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). And, Examiner notes that claims are given their broadest reasonable construction. See *In re Hyatt*, 211 F.3d 1367, 54 USPQ2d 1664 (Fed. Cir. 2000).

And, Examiner notes that Applicant's claims minimally state how any interaction between the anonymous and identifying information occurs. The claims only disclose an item provider server. The claims do not state that different parties are involved or how different parties interact. The claims do not state that the anonymous information and identifying information come from different sources. The claims do not state that the anonymous information and identifying information are for the same client.

Also, Examiner notes that Bergh discloses that user information can be stored on multiple servers (col 12, lines 42-50).

Conclusion

The following prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

a) Bieganski (6,321,221), Lokuge (5,907,836), Sumita (5,907,836) disclose recommendation inventions with relevant features;

b) Dedrick (5,724,521) and Goldhaber (5,794,210) disclose charging for information providing and protecting user privacy.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period

will expire on the date the advisory action is mailed, and any extension fee pursuant to 37

CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

however, will the statutory period for reply expire later than SIX MONTHS from the mailing

date of this final action.

Any inquiry concerning this communication or earlier communications from the

examiner should be directed to Arthur Duran whose telephone number is (571) 272-6718. The

examiner can normally be reached on Mon- Fri, 8:00-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Eric Stamber can be reached on (571) 272-6724. The fax phone number for the

organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent

Application Information Retrieval (PAIR) system. Status information for published applications

may be obtained from either Private PAIR or Public PAIR. Status information for unpublished

applications is available through Private PAIR only. For more information about the PAIR

system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR

system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would

like assistance from a USPTO Customer Service Representative or access to the automated

information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Arthur Duran
Primary Examiner
Art Unit 3622

5/14/2007